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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,369	11/06/2001	Hongbiao Li	5011-0005	5575

7590
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12/15/2004

EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/992,369	Applicant(s) LI, HONGBIAO	
	Examiner Edwin C. Holloway, III	Art Unit 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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EXAMINER'S RESPONSE

1. In response to the application filed 11-06-2001, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 102 & 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-8, 10 and 12-18 rejected under 35 U.S.C. 102([]) as being anticipated by Moore (US 5592561). Regarding claims 1 and 12, Moore discloses a system and method including an authenticator (host computer 14) with a processor (col. 20 line 2) storing authentication data (database in col. 20 lines 10-20 and col. 10 lines 24-37). A product (goods) stores product data in col. 12 lines 29-46 that is extracted by an interface (field reader 18) and sent to the authenticator in col. 20 lines 31-54 for comparison to the authentication data to determine that the product is authentic if comparison is acceptable in col. 19 lines 20 - col. 20 line 9. Regarding claims 2-3 and 17-18, the product data is concealed by extraneous data 56 in col. 15 lines 22-40. Also, the markings are not readily visible to the eye in col. 12 line 46 - col. 13 line 7 and col. 15 lines 50-64. Regarding claim 4, different types of data (manufacturer ID, place of manufacture, UPC, logo, etc.) are included in col. 12 lines 29-46, col. 13, lines 18-30 and col. 14 lines 4-53. Regarding claim 5 and 15, Moore includes comparing a range in col. 29 lines 23-27 and col. 2 lines 29-35. Regarding claims 6 and 16, Moore includes comparing a distinctive value because symbols are compared in col. 19 lines 20-25 and the symbols are

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distinct in col. 13 lines 20-25 and unique in col. 15 lines 22-28. Further col. 19 lines 28-39 includes checking origin data that is a distinct value. Regarding claim 7 and 13, the host database of Moore includes supplemental data such as audit trail information in col. 22 lines 8-20 and other pertinent information in col. 8 line 5. Regarding claims 8, 10 and 14, visual indication (display) of acceptable comparison (valid) and not acceptable comparison (invalid) is provided in col. 8 lines 1-9.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (US 5592561) as applied above in view of Doljack (US 6442276). Doljack discloses an analogous art system for authenticating goods with either audible or visual indicator comparison in col. 9 lines 9-50. In particular, see col. 9 line 14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included audible indication of Doljack in the system of Moore because Moore includes visual indication and Doljack teaches that audible and visual indication are interchangeable for indicating whether goods are authentic or counterfeit.

6. Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (US 5592561) as applied above in view of Kaish (US 5974150). Kaish discloses an analogous art

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system and method for authentication of goods having means to erase the authentication memory upon detecting tampering such as improper access. See col. 17 lines 17-25 and col. 25 lines 7-41. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the erasing of memory in response to improper access of Kaish in the system and method of Moore in order to provide secure memory that is protected against tampering and suggested by Moore discussing a tamper proof card with memory in col. 9 lines 50-55.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Katz (US 4558318) discloses merchandise verification with supplemental information for tracking and Knop (US 4661983) discusses secure document authentication with comparison for substantially exactly matching.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll

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free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
12/7/04


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
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